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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,567	09/27/2000	Ming-Tsun Hsieh	JCLA5635	4641

7590  
J C Patents INC  
4 Venture  
Suite 250  
Irvine, CA 92618

04/08/2004

EXAMINER
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VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/671,567

Applicant(s)

HSIEH, MING-TSUN

Examiner

John M. Villecco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 9/27/00
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:

- On page 4, lines 13, 15, 16, and 20, applicant repeats the phrase "Sensor\_addr" twice. This appears to be a typographical error.

Appropriate correction is required.

### ***Claim Objections***

2. Claim 10 objected to because of the following informalities:

- Regarding claim 10, applicant recites the phrase "during the image sensor is tested". This phrasing is hard to understand.
- Also in claim 10, applicant recites the phrase "a address comparator". It appears that the applicant meant to use the phrase – an address comparator –.

Appropriate correction is required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. **Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,642,961.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons discussed below.

5. Claim 1 of the applicant's invention (hereinafter referred to as '567) is broader in scope than claim 1 of the patent (hereinafter referred to as '961). Therefore, any patent granted on it would result in the unjustifiable timewise extension of the monopoly granted on claim 1 of the '961 patent. Additionally, it is important that these two inventions are always commonly owned.

6. Claim 2 of application '567 is verbatim the same as claim 2 of the '961 patent.

7. Claim 3 of application '567 is verbatim the same as claim 3 of the '961 patent.

8. Claim 4 of application '567 is verbatim the same as claim 4 of the '961 patent.

9. Claim 5 of the applicant's invention (hereinafter referred to as '567) is broader in scope than claim 5 of the patent (hereinafter referred to as '961). Therefore, any patent granted on it

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would result in the unjustifiable timewise extension of the monopoly granted on claim 5 of the '961 patent. Additionally, it is important that these two inventions are always commonly owned.

10. Claim 6 of application '567 is verbatim the same as claim 6 of the '961 patent.
11. Claim 7 of application '567 is verbatim the same as claim 7 of the '961 patent.
12. Claim 8 of application '567 is verbatim the same as claim 8 of the '961 patent.
13. Claim 9 of application '567 is verbatim the same as claim 9 of the '961 patent.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. **Claims 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by**

**Younse et al. (U.S. Patent No. 4,805,023).**

16. Regarding *claim 10*, Younse discloses a CCD imager defect compensator which includes a PROM (11) for storing a plurality of defective pixel addresses and a comparator (13) for comparing the defective pixel address with the current pixel address from the pixel address counter (15). When the defective pixel address and the pixel address are the same an inhibit signal is output. This is interpreted to be a defective pixel flag since it is designating that the current pixel is a defective pixel. See column 2, line 43 to column 3, line 30.
17. As for *claim 12*, Younse discloses the use of a line pointer which supplies the address for the PROM (33). The line pointer is interpreted to be the index. See column 3, lines 36-38.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Younse et al. (U.S. Patent No. 4,805,023).**

20. Regarding *claim 13*, as mentioned above in the discussion of claim 10, Younse discloses all of the limitations of the parent claim. However, Younse fails to specifically disclose that the defective pixel addresses are arranged in an ascending order in the memory element. However, one of ordinary skill in the art would have found it obvious to arrange the defective pixel address in ascending order so that when reading out the defective pixel addresses the system does not have to jump around the memory to find a the next defective pixel address.

21. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Younse et al. (U.S. Patent No. 4,805,023) in view of Heller et al. (U.S. Patent No. 6,396,539).**

22. Regarding *claim 11*, as mentioned above in the discussion of claim 10, Younse discloses all of the limitations of the parent claim. However, Younse fails to specifically disclose that the memory element is a fuse array. Heller, on the other hand, discloses that it is well known in the art to use a fuse array to store defective pixel addresses. More specifically, Younse discloses a fuse memory (14) for storing the defective pixel locations of the imager (12). It is well known in

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the art that a fuse memory is a type of PROM. The use of a fuse memory is a more specific memory arrangement for use in Younse and one of ordinary skill in the art would have taken into consideration the different types of memories for storing the defective pixel addresses. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a fuse memory for the PROM memory of Younse.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9306 (For either formal or informal communications intended for entry. For informal or draft communications, please label **"PROPOSED"** or **"DRAFT"**)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (703) 305-1460.

The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Villecco  
April 5, 2004



NGOC-YEN VU  
PRIMARY EXAMINER